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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

10017812-1

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on 11-21-05

Signature Shanne BourguignonTyped or printed name SHANNE BOURGUIGNON

Application Number

10/011,857

Filed

11/06/2001

First Named Inventor

DEBENDRA DAS SHARMA

Art Unit

2111

Examiner

KHAH DANG

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 39,906☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

Robert W. Bergstrom  
Signature

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Telephone number

11-21-05

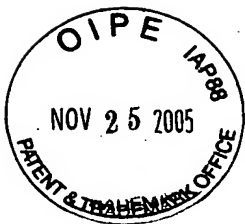
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☒\*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

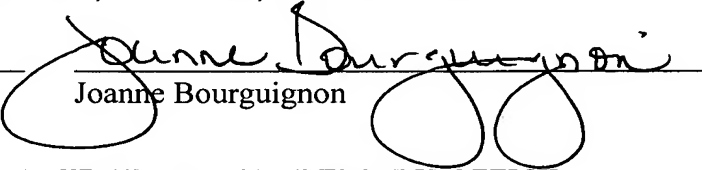
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## PATENT

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11-21-05  
Date

  
Joanne Bourguignon

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Debendra Das Sharma  
Application No.: 10/011,857  
Filed: November 5, 2001  
Title: Method and System for Controlling Flow of Ordered, Pipelined Transactions between Intercommunicating Electronic Devices

Examiner: Khanh NMN Dang  
Art Unit: 2111  
Docket No.: 10017812-1  
Date: November 21, 2005

MAIL STOP AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicant requests review of the Final Rejection in the above-identified application. No amendments are being filed with this request. The request is being filed with a Notice of Appeal.

ARGUMENTS

1. Applicant has twice filed Declarations of prior invention under 37 CFR § 1.131 with respect to the cited reference Uchara et al., U.S. Patent Application Publication No. 2002/0040414 A1 ("Uchara") which have not been properly considered and responded to by the Examiner.

In an Office Action dated May 4, 2004, the Examiner rejected claims 1 and 4-15 under 35 U.S.C. § 102(e) as being anticipated by Uchara. In a Response filed August 4, 2004, Applicant's representative submitted a 37 CFR § 1.131 Declaration in which Applicant declared that he had conceived of the claimed invention prior to the July 3, 2001 effective date of the cited reference. In a subsequent Office Action, dated July 21, 2005, the Examiner stated:

In response to Applicants' argument, the declaration under 36 CFR 1.131 filed 8/10/2004 is insufficient to overcome the rejection of claims 1, 4-15 over Uchara under 35 USC § 102(e) as set forth in the last Office action because it is not properly executed and fails to establish reduction to practice prior to the date of the reference. ... In the affidavit Applicants state that the invention was reduced to practice. However, a written description does not constitute an actual reduction to practice. Furthermore, only the filing of a US patent application which complies with the disclosure requirement of 35 U.S.C. § 112 constitutes a constructive reduction to practice. A written description, no matter how complete, which has not been made the subject of a US patent application does not qualify as reduction to practice. In any event, it is Applicants' acknowledgement that the invention is not built or tested ...

The Examiner did not indicate why the previously submitted Rule 131 Declaration is not properly executed. It is complete, and is signed and dated by Applicant. In the Rule 131 Declaration, Applicant did not state that the invention was reduced to practice, but instead stated that he conceived the invention prior to the date of the cited reference, and that, following conception, he diligently pursued a constructive reduction to practice. The Examiner's statement seems to indicate a misunderstanding of Rule 131 Declaration practice, and the statutes on which the practice is based. Filing of the Current Application constitutes a constructive reduction to practice. As stated in 35 C.F.R. § 1.131(b):

The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. (emphasis added)

In a Response After Final under 37 C.F.R. § 1.116 dated September 21, 2005, Applicant's representative pointed out to the Examiner that the previously filed Rule 131 Declaration establishes conception of the invention prior to the effective date of the reference

coupled with due diligence from the prior said date, and, in addition, submitted a newly executed Rule 131 Declaration intended to correct any deficiencies in the originally submitted Rule 131 Declaration, even though the deficiencies were not pointed out clearly by the Examiner, and Applicant's representative did not understand why the previously submitted Rule 131 Declaration was improperly executed. In an Advisory Action dated October 11, 2005, the Examiner apparently maintains the rejections of claims 1 and 4-15, and does not address Applicant's representative's arguments concerning the original Declaration nor the second Declaration.

According to MPEP § 715.07, "[W]hen reviewing a 37 CFR 1.131 affidavit or declaration, the Examiner must consider all of the evidence presented in its entirety, including the affidavits or declarations and all accompanying exhibits, records, and "notes." In Applicant's representative's respectfully submitted opinion, the Examiner's original rejection of the originally filed Rule 131 Declaration indicates that the Examiner does not fully understand 37 CFR § 1.131 and did not consider the originally submitted Rule 131 Declaration. The Examiner has not responded in any way to the second Rule 131 Declaration submitted by Applicant's representative, lacking clear direction from the Office Action dated July 21, 2005, in order to overcome any deficiencies in the originally submitted Rule 131 Declaration. Applicant's representative believes that Applicant should have received a substantive and correctly considered response to the Rule 131 Declaration prior to a final rejection, and that the Examiner's initial failure to distinctly point out why the originally filed 131 Declaration was improperly executed, and failure to respond to Applicant's representative's arguments, constitutes a clear error.

2. In an Advisory Action dated October 11, 2005, the Examiner has improperly declined to consider claim amendments submitted in a Response After Final under 37 C.F.R. § 1.116, dated September 21, 2005.

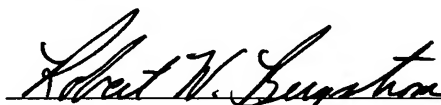
In an Office Action dated May 4, 2004, the Examiner rejected claims 1-20 under 35 U.S.C. § 112, second paragraph. In a Response filed August 4, 2004, Applicant's representative amended 1, 10, 15, and 16 to address several of these 35 U.S.C. § 112, second paragraph rejections, and carefully explained why Applicant's representative believes that

other of the submitted 35 U.S.C. § 112, second paragraph rejections were unfounded. In a subsequent Office Action finally rejecting claims 1-20, dated July 21, 2005, the Examiner responded at some length to Applicant's representative's arguments with respect to the 35 U.S.C. § 112, second paragraph. Although Applicant's representative does not agree with these rejections, or with the Examiner's reasoning, Applicant's representative nonetheless further amended the claims, in a Response After Final under 37 C.F.R. § 1.116 dated September 21, 2005, in order to further prosecution. In an Advisory Action dated October 11, 2005, the Examiner declined to consider or enter the claim amendments submitted to address the 35 U.S.C. § 112, second paragraph rejections, indicating that the amendments would raise new issues or require a new search. Applicant's representative respectfully disagrees. These amendments were submitted solely to overcome the 35 U.S.C. § 112, second paragraph rejections, and neither introduce new matter nor change the scope of the claims to a degree sufficient to require a new search, if at all. Applicant's representative has attempted to carefully consider and respond to the Examiner's position, and feels that the Examiner has too quickly, and without proper consideration, rejected Applicant's representative attempts to address the 35 U.S.C. § 112, second paragraph rejections.

CONCLUSION

Applicant's representative believes that Applicant's Rule 131 Declaration has not been properly considered by the Examiner, and that the Examiner has not properly responded to multiple submissions of Applicant's Rule 131 Declarations. Applicant's representative also believes that the Examiner has improperly failed to consider claim amendments submitted in a Response After Final under 37 C.F.R. § 1.116.

Respectfully submitted,  
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Enclosures:

Postcards (2)  
Transmittal in duplicate

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